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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,477	02/23/2004	Stefan Hein	HANZ-206	1721
24972	7590	09/20/2006	EXAMINER	
FULBRIGHT & JAWORSKI, LLP			MOORE, KARLA A	
666 FIFTH AVE			ART UNIT	
NEW YORK, NY 10103-3198			PAPER NUMBER	
			1763	
DATE MAILED: 09/20/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,477

Applicant(s)

HEIN ET AL.

Examiner

Karla Moore

Art Unit

1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 16, 17, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 10-15, 18 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. There is insufficient antecedent basis for the limitation in the above claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
9. Claims 1-3, 6, 16-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 101 57 186 C1 to Erbkamm et al.
10. Erbkamm et al. disclose a web coating apparatus having a vacuum chamber (1) which has between a back wall and at least one removable closing plate: a shield with a flat cover (22), at least one guide roll (13) and a coating cylinder (15 and 16) with an axis, A, as well as at least one coating source

Art Unit: 1763

(abstract) being disposed in the vacuum chamber, wherein the ends of the at least one guide roll and of the coating cylinder which face the closing plate are fastened to the cover with bearings and that the space in the vacuum chamber underneath the coating cylinder is kept free of supporting elements (see Figures 1 and 2; abstract).

11. With respect to claims 2 and 3, the coating cylinder is journaled on the back wall. One of ordinary skill in the art would recognize that the same mechanism could be provided for the guide rolls as the function similarly (see Figure 2).

12. With respect to claim 6, within the vacuum chamber at least four sub chambers are formed on the circumference of the coating cylinder by dividing walls (17).

13. With respect to claim 16, the size of the apparatus would be adapted to meet processing needs (e.g. substrate to be processed, desired throughput, etc.).

14. With respect to claims 17 and 20, the vacuum chamber has on each side of the coating cylinder a side chamber (2 and 3) in which a winding mandrel, one for an unwinding roll (4 or 5) and one for a winding roll (4 or 5) as well as corresponding guide rolls (13). Further, at the upper sides of the side chambers lie at least substantially at the same level as the cover of the vacuum chamber.

15. Claims 4-5, 7-9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erbkamm et al. as applied to claims 1-3, 6, 16-17 and 20 above, and further in view of U.S. Patent No. 2,925,062 to Schwindt.

16. Erbkamm et al. disclose the invention substantially as claimed and as described above.

17. However, Erbkamm et al. fail to teach dividing walls for dividing the space underneath and laterally of the coating cylinder which have at their ends facing the coating cylinder sealing means whose curvature is adapted to the radius of the coating cylinder such that between the sealing elements and the coating cylinder arcuate sealing means whose curvature is adapted to the radius of the coating cylinder such that between the sealing elements and the coating cylinder arcuate sealing gaps are formed.

Art Unit: 1763

18. Schwindt teaches providing a plurality of gates and corresponding arcuate sealing members for the purpose of readily adjusting the clearance between separate sections of the coating apparatus (column 1, rows 52-64 and column 2, rows 43-68).

19. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to have provided a plurality of gates and corresponding arcuate sealing members in Erbkamm et al. in order to readily adjust the clearance between separate subsections of the coating apparatus as taught by Schwindt.

20. With respect to claims 7-8, the dividing walls as claimed, see Figure 1 of Schwindt.

21. With respect to claim 9, guide rolls can be provided as needed in both Erbkamm and Schwindt in order to support and guide the web being processed.

22. With respect to claim 19, Schwindt teaches providing separate sections (subchambers and sidechambers) of a coating apparatus to separate vacuum pumps (column 3, rows 29-44).

Allowable Subject Matter

23. Claims 10-15 and 18 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record fails to teach or fairly suggest dividing wall have at their ends opposite from the back wall radially running sealing bars against which the closing plate can be placed in contact, as recited in claims 10-12 and 18. The prior art of record further fails to teach or suggest the coating cylinder is surrounded at its ends within subchambers by strip-like masks covered cylindrically coaxially, which extend around the said ends with tight clearance and shield the coating cylinder against coating of their surface portions not covered by the web, as recited in claims 13-15 and 21. Additionally, no other properly combinable art was located to supply the missing features along with the requisite motivations.

Response to Arguments

24. Applicant's arguments filed 07 July 2006 have been fully considered but they are not persuasive.

Art Unit: 1763

25. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The majority of applicant's arguments are based on the deficiencies of the Schwindt reference to disclose or suggest features of the claimed invention for which the reference is not relied upon. Erbkamm discloses and/or fairly suggests the majority of the claimed invention and therefore was the reference relied upon for many of the features which Applicant argues are not found in Schwindt. See above rejection.

26. Applicant also argues that the two references cannot be combined in a rejection of the claims because they do not possess the same features. Examiner points out that if they shared the same features, there would be no reason to combine the references. It has been held that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

27. Examiner maintains that Erbkamm discloses a web coating apparatus substantially as claimed and as described above. Schwindt supplies the missing teachings not disclosed in Erbkamm, also described above.

Conclusion

28. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action

Art Unit: 1763

is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karla Moore whose telephone number is 571.272.1440. The examiner can normally be reached on Monday-Friday, 9:00 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Parviz Hassanzadeh can be reached on 571.272.1435. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karla Moore
Primary Examiner
Art Unit 1763
15 September 2006